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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/045,954

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James Cohen

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06/16/2006

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Huntington Beach, CA 92649

EXAMINER

ONI, OLUBUSOLA

ART UNIT

PAPER NUMBER

2168

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/045,954	COHEN, JAMES	
	Examiner	Art Unit	
	OLUBUSOLA ONI	2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/06/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Application filed on 02/20/2003

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 12 is rejected under 35 U.S.C 101 because the claimed invention is directed to a non-functional descriptive material. Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. **Merely claiming nonfunctional descriptive material does not make the invention eligible for patenting.** A claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

In claim 21 "a method of tracking" is recited; however this claim is rejected because it is a practical application which does not produce any tangible results, and as such it is not limited to tangible patent-eligible subject matter.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Gallagher et al.(Patent No. 6003763) hereinafter "Gallagher".

For claim 1, Gallagher teaches "a method for tracking physical property with an American Banking Association routing number (Col. 7, lines 49-67), the method comprising: "associating a tracking number with an item of physical property, wherein the tracking number comprises at least an American Banking Association routing number" (Col. 5, lines 54-64)

"recording in a database a description of the physical property" (Col. 5, lines 62-Col. 6, lines 1-11)

"associating within the database the tracking number with the description about the physical property" (Col. 5 lines 62-65)

Art Unit: 2168

For claim 2, Gallagher teaches “wherein associating the tracking number with the item of physical property comprises attaching a label displaying the tracking number to the item of physical property” (Col. 7, lines 49-67)

For claim 3, Gallagher teaches “wherein associating the tracking number with the item of physical property comprises printing the tracking number on the item of physical property” (Col. 7, lines 49-67, fig. 6)

For claim 4, Gallagher teaches “wherein associating the tracking number with the item of physical property comprises attaching a negotiable instrument comprising the tracking number to the item of physical property” (Col. 7, lines 49-65)

For claim 5, Gallagher teaches “wherein the description of the physical property comprises a description about the owner of the physical property” (Col. 13, lines 1-6)

For claim 6, Gallagher teaches “ wherein the description of the physical property comprises a description about the possessor of the physical property” (Col. 13, lines 1-6)

For claim 7, Gallagher teaches “storing information about an item in a database” (Col. 5, lines 62-Col. 6, lines 1-11)

Art Unit: 2168

“associating within the database a tracking code with the information about the item wherein the tracking code also identifies a negotiable instrument”(Col. 5, lines 62-Col. 6, lines 1-11, Col. 11, lines 3-10)

“registering in the database an owner of the item transferring ownership of the item to a second party” (Col. 10, lines 62-Col. 11, lines 12)

“changing the registered owner of the item in the database to the second party” (Col. 11, lines 31-60)

For claim 8, Gallagher teaches “wherein the tracking code comprises a financially recognized tracking number, and wherein the tracking number comprises at least an American Banking Association routing number” (Col. 7, lines 49-67)

For claim 9, Gallagher teaches “wherein the tracking code comprises a financially recognized tracking number, a payer, a payee, and a face value amount” (Col. 7, lines 22-60)

For claim 10, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 7 and is similarly rejected

For claim 11, Gallagher teaches “wherein the tracking code comprises a credit card number and a check number” (Col. 7, lines 49-67, Col. 10, lines 62-67)

Art Unit: 2168

For claim 12, Gallagher teaches “a database for registering and tracking items, the database storing a plurality of items (Col. 5, lines 62-Col. 6, lines 1-11)

, each of the stored items comprising:

“a financially recognized tracking number associated with the item” (Col. 7, lines 22-26)

“a name of the item” (Col. 7, lines 49-65)

“a registered owner of the item”(Col.10, lines 60-Col. 11, lines 1-2)

For claim 13, Gallagher teaches “wherein at least one of the stored items further comprises a registered possessor of the item”(Col. 7, lines 27-48)

For claim 14, Gallagher teaches “wherein at least one of the stored items further comprises an insurance company of the item” (Col. 7, lines 49-60)

For claim 15, Gallagher teaches “wherein at least one of the stored items further comprises a transaction history of the item” (Col.7, lines 27-48)

For claim 16, Gallagher teaches “wherein at least one of the stored items further comprises a physical location of the item” (Col. 13, lines 1-6)

For claim 17, Gallagher teaches “receiving a request to redeem a negotiable instrument, the negotiable instrument including a tracking number that uniquely identifies the negotiable instrument” (Col 11, lines 1-30)

Art Unit: 2168

“entering the tracking number into a database to retrieve a corresponding registration record of the negotiable instrument” (Col. 11, lines 13-20, Col. 13, lines 34-60)

“comparing the retrieved registration record with the negotiable instrument” (Col. 11, lines 21-67)

“redeeming the negotiable instrument if data associated with the registration record relates to data associated with the negotiable instrument” (Col. 14, lines 5-20)

For claim 18, Gallagher teaches “wherein receiving a request to redeem a check comprises receiving a request to redeem an electronic check” (Col. 6, lines 1-11)

For claim 19, Gallagher teaches “ wherein comparing the retrieved registration record with the negotiable instrument comprises comparing a registered payment amount of the retrieved registration record with a face value of the negotiable instrument”([Col. 13, lines 35-54] wherein the central database is check for verification of the check)

For claim 20, Gallagher teaches “ wherein comparing the retrieved registration record with the negotiable instrument comprises comparing a registered payee name of the retrieved registration record with a payee name of the negotiable instrument” ([Col. 13, lines 35-54] wherein the central database is check for verification of the check)

Art Unit: 2168

For claim 21, Gallagher teaches “a method of tracking an item with a financially recognized tracking number, the method comprising: associating within a database a tracking code with data about an item, wherein the tracking code comprises financially recognized identification information” (Col. 11, lines 3-10)

For claim 22, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 7 and is similarly rejected

Art Unit: 2168

CONCLUSION

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUBUSOLA ONI whose telephone number is 571-272-2738. The examiner can normally be reached on 7.30-5.00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TIM VO can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OLUBUSOLA ONI
Examiner
Art Unit 2168



KHANH B. PHAM
PRIMARY EXAMINER